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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055398
Party	Defendant The Cochran Firm, P.C.
Correspondence Address	THE COCHRAN FIRM PC 163 W MAIN STREET DOTHAN, AL 36301 UNITED STATES
Submission	Answer
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Attorney Ref. No.: 6511.001-01

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Randy H. McMurray P.C.)	
Petitioner,)	
)	
v.)	Cancellation No. 92055398
)	Reg. No. 2930153
)	Mark: THE COCHRAN FIRM
)	
The Cochran Firm, P.C.,)	
Registrant.)	
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ANSWER TO CANCELLATION PETITION

The Cochran Firm, P.C., ("Registrant"), hereby answers the Petition for Cancellation of plaintiff, Randy H. McMurray P.C., ("Petitioner"), to Registrant's trademark Registration No. 2930153, as follows:

Petition Paragraph No. 1

Petitioner is the owner of valuable rights in the mark THE COCHRAN FIRM in connection with services similar or identical to those identified in the '153 Registration, as well as of the business and goodwill connected therewith.

Answer to Paragraph No. 1

Denied

Petition Paragraph No. 2

Petitioner is a professional corporation organized under the laws of California comprising Randy H. McMurray, an individual and attorney. Petitioner's renown stemming from his many years of work, including as an associate and partner of the renowned attorney Johnnie Cochran, and as a member of his law firm, which has long been known as "The Cochran Firm", as well as his continuing work with and management of the principal office in Los Angeles of the firm after the death of Mr. Cochran and formation of a new law partnership under the "The Cochran Firm Los Angeles" name (the "LA Partnership"), extends throughout Southern California and North America.

Answer to Paragraph No. 2

Admitted that petitioner is a professional corporation organized under the laws of California comprising Randy H McMurray, an individual and attorney. Petitioner's claim of renown is denied to the extent it calls for a subjective evaluation. Registrant is aware that permission was given by the Registrant to the Petitioner and attorney Brian Dunn to form a new law partnership under the name The Cochran Firm Los Angeles. In said partnership agreement as amended and as duly executed by the petitioner it agrees and acknowledges in SECTION 1.02 of the Agreement that *"The name of the Partnership... shall be The Cochran Firm Los Angeles, provided however, the name 'Cochran' is used by the Partnership under license from the Cochran Firm and its partners, Samuel A. Cherry, Jr., J. Keith Givens and Jock Smith (the National Firm). In the event such license expires or is revoked, the partnership shall adopt another name."*

Petition Paragraph No. 3

On information and belief, Registrant is a professional corporation organized under the laws of Alabama with a principal address of 163 West Main Street, Post Office Box 927, Dothan, Alabama 36302.

Answer to Paragraph No. 3

Admitted

Petition Paragraph No. 4

After the 2005 death of the original registrant, Johnnie Cochran, ownership of the registration appears to have passed to his estate. (However, in the absence of an assignment and continuing license addressing the goodwill from the firm's ongoing activities under the THE COCHRAN FIRM mark, the rights of the Estate of Johnnie L. Cochran Junior (the "Estate") are believed to have extinguished at that time as a result of a naked assignment and non-use by the assignee, the Estate.

Answer to Paragraph No. 4

Admitted that ownership of the registration passed to Johnnie Cochran's estate. Denied that the rights of the Estate to the registration were extinguished as a result of a naked assignment and non-use by the assignee, the Estate.

Petition Paragraph No. 5

Notwithstanding the foregoing, in 2007, The Estate executed and had recorded in the U.S. Trademark Office an Assignment of its entire interest in the registration to Registrant.

Answer to Paragraph No. 5

Admitted that the Estate executed and had recorded in the U.S. Trademark Office an Assignment of its entire interest in the registration to Registrant. Denied that the rights of the Estate were extinguished as a result of a naked assignment and non-use by the assignee, the Estate as intimated.

Petition Paragraph No. 6

On information and belief, neither Mr. Cochran nor his estate had in place any written or other license agreement governing the use of the THE COCHRAN FIRM mark by the law firm.

Answer to Paragraph No. 6

Denied

Petition Paragraph No. 7

On information and belief the business and goodwill in the THE COCHRAN FIRM mark were not transferred to the Estate. The assignment of rights in the subject mark of the '153 Reg. to Registrant was therefore a naked license, and the Registration is invalid.

Answer to Paragraph No. 7

Denied

Petition Paragraph No. 8

Even if the foregoing assignment of the '153 Reg. is valid, which Petitioner does not concede, there is no license agreement between Registrant and Petitioner, either as an individual member or as managing partner of the LA Partnership in the principal office of the late Mr. Cochran's firm, which has for several years operated as a California limited liability partnership under the name "The Cochran Firm Los Angeles". The parties have not emplaced terms governing good will in connection with the mark, or quality control; therefore there is no valid license that may be found to exist even implicitly between the parties, and the Registration is invalid.

Answer to Paragraph No. 8

Denied

Petition Paragraph No. 9

On information and belief, Registrant has no license agreements with any of the Registrant's other purported licensees/affiliates providing for good will generated by use of the subject mark of the '153 Reg. to inure to Registrant.

Answer to Paragraph No. 9

Denied

Petition Paragraph No. 10

Petitioner and the LA Partnership are not and for many years have not been members of the Registrant's organization and/or professional corporation, and the parties to this proceeding are thus not part of one single firm, nor otherwise comprising a common entity, as such terms are commonly understood in the context of law practices.

Answer to Paragraph No. 10

Denied

Petition Paragraph No. 11

On June 7, 2011, Registrant filed a Declaration of Continuing Use under Section 8 in the '153 Reg. with a supporting specimen. According to the Declaration, the supporting specimen comprises "the Cochran firm brochure".

Answer to Paragraph No. 11

Admitted

Petition Paragraph No. 12

The specimen identifies a number of cities, including Los Angeles, as locations where Registrant maintains offices. However, the LA Partnership is a separate and distinct business organization from Registrant, as is borne out in the LA Partnership's Amended and Restated Partnership Agreement dated as of January 1, 2010, which does not identify Registrant nor any of its individual members as partners or members of the LA Partnership.

Answer to Paragraph No. 12

Admitted that the specimen identifies a number of cities, including Los Angeles , as locations where Registrant maintains offices but denies that it is a separate and distinct business organization as borne out by the express language of the *"LA Partnership's Amended and Restated Partnership Agreement dated as of January 1, 2010"* which specifically provides that the partnership operates "under license from The Cochran Firm" (your Registrant herein) with said license extended under agreement of compliance with the operating provisions of the Cochran Firm. The Cochran Firm Los Angeles operated as a Cochran Firm partner until January, 2012.

Petition Paragraph No. 13

The specimen fraudulently misrepresents Registrant as a firm where "The Partners of The Cochran firm have won" a variety of impressive verdicts,

specifically: Eleven verdicts in excess of \$100 Million; Over 36 verdicts in excess of \$10 Million; Hundreds of verdicts or settlements in excess of \$1 Million; Over \$1 Billion obtained in environmental settlements or verdicts, while in truth, Registrant's partners/shareholders have not obtained those results between them.

Answer to Paragraph No. 13

Denied

Petition Paragraph No. 14

The specimen fraudulently misrepresents Registrant as "America's Law Firm", where consumers are led to believe the firm is operating in 21 cities throughout the country, in Atlanta, Birmingham, Chicago, Dallas, Detroit, Dothan, Houston, Huntsville, Jackson, Las Vegas, Los Angeles, Memphis, Miami, Minneapolis, Milwaukee, Mobile, New Orleans, New York, Philadelphia, Tuskegee, and Washington, DC.

Answer to Paragraph No. 14

Denied

Petition Paragraph No. 15

On information and belief, Registrant is not organized as a law firm partnership or corporation with satellite offices in the cities identified in Paragraph 14, above.

Answer to Paragraph No. 15

Denied

Petition Paragraph No. 16

On information and belief Registrant operates a naked licensing scheme with law practitioners in the cities identified in Paragraph 14 concerning use of the THE COCHRAN FIRM mark, where said practitioners are not required to maintain any level of quality controlled or enforced by Registrant, therefore the statements in the specimen are false and fraudulently misrepresentative, tainting the Section 8 Declaration of Use.

Answer to Paragraph No. 16

Denied

Petition Paragraph No. 17

Registrant has not won verdicts and settlements amounting to the sums alleged in Paragraph 13, above, either alone or through licensees operating under valid trademark licenses.

Answer to Paragraph No. 17

Denied

Petition Paragraph No. 18

Registrant does not operate as a single firm nor as an association through valid licenses in the 21 cities identified in its specimen supporting its Section 8 Declaration.

Answer to Paragraph No. 18

Denied

Petition Paragraph No. 19

Petitioner has developed strong trademark rights and goodwill in the THE COCHRAN FIRM mark since becoming the director and managing partner of the Los Angeles office after the death of Mr. Cochran. He has maintained and grown the practice since that time, operating in and from the Los Angeles office, which was the principal office of the firm during the period that Mr. Cochran was practicing and managing the firm, and the Los Angeles office is still regarded by consumers as the principal location of "THE COCHRAN FIRM".

Answer to Paragraph No. 19

Denied that Petitioner has developed strong trademark rights and goodwill in The Cochran Firm mark "since" becoming the managing partner after the death of Mr. Cochran.

Petitioner's claim suggests incorrectly that Petitioner became the managing partner of the LA Cochran office immediately following Mr. Cochran's death in 2005. The petitioner has not been the managing partner of the LA Cochran office since the death of Mr. Cochran. Registrant admits that the Los Angeles office of the Cochran Firm was an office maintained by the Registrant for the last seven years of Mr. Cochran's life and had been maintained by Mr. Cochran for a number of years prior thereto. Registrant is without sufficient knowledge to form a belief as to the truthfulness of the claim that consumers regard the LA office as the principal location of the Cochran Firm so this claim is denied.

Petition Paragraph No. 20

Petitioner first learned of the '153 Registration when, on February 6, 2012, Registrant sent Petitioner a threatening letter demanding Petitioner cease and desist use of THE COCHRAN FIRM mark, notwithstanding the good will that has inured to Petitioner over the course of the past several years of Petitioner's and the LA Partnership's use.

Answer to Paragraph No. 20

Denied. Petitioner had at least constructive notice of the Registrant's claim of ownership rights to the registered mark well prior to February 6, 2012 since the THE COCHRAN FIRM mark issued on the Principal Register on March 8, 2005. Further, by virtue of the express language of the *LA Partnership's Amended and Restated Partnership Agreement* the Petitioner has duly acknowledged the Registrants' ownership of the rights associated with the use of the Cochran name in its practice.

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Petition Paragraph No. 21

Registrant does not have valid and enforceable rights in the THE COCHRAN FIRM mark as a result of the naked assignment and/or naked licensing of the mark by Registrant and/or its predecessor(s) in interest, inter alia.

Answer to Paragraph No. 21

Denied

Petition Paragraph No. 22

Registrant's improper use of its fraudulent and invalid registration is threatening Petitioner's ability to conduct its business and is interfering with same, to the detriment of Petitioner and Petitioner's clients. Petitioner's lawful use of its THE COCHRAN FIRM mark will be impaired by continued registration of Registrant's mark and thus, Petitioner believes it will be damaged by the continuance of registrant's registration.

Answer to Paragraph No. 22

Denied

RELIEF REQUESTED

23. Registrant requests that the Board dismiss this Cancellation and grant final judgment in favor of Registrant, in entirety.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

24. The Petition for Cancellation, and each claim therein, fails to assert facts sufficient to constitute grounds for Cancellation.

SECOND AFFIRMATIVE DEFENSE

25. Each of Petitioner's claims is barred by the doctrine of laches.

THIRD AFFIRMATIVE DEFENSE

26. Each of Petitioner's claims is barred by the doctrine of estoppel.

FOURTH AFFIRMATIVE DEFENSE

27. Each of Petitioner's claims is barred by the doctrine of waiver.

FIFTH AFFIRMATIVE DEFENSE

28. Each of Petitioner's claims is barred by the doctrine of acquiescence.

SIXTH AFFIRMATIVE DEFENSE

29. Petitioner has failed to plead facts sufficient to show an ownership interest in the trademark in question.

ADDITIONAL AFFIRMATIVE DEFENSES

30. Registrant hereby incorporates by reference those Affirmative Defenses enumerated in *Rule 8 of the Federal Rules of Civil Procedure* as if fully set forth at length herein. In the event further investigation or discovery reveals the applicability of any such defenses, Registrant reserves the right to seek leave to amend its Answer to specifically assert the same. Said Defenses are incorporated by reference for the specific purpose of not waiving the same.

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In view of the above allegations, Registrant requests that the Board dismiss this Cancellation and grant final judgment in favor of Registrant, in entirety.

Respectfully submitted,

Date: May 3, 2012

TDFoster - Intellectual Property Law

/Thomas D. Foster/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing “ANSWER TO CANCELLATION PETITION” was served on May 3, 2012 by first-class mail, postage prepaid, to Petitioner’s counsel addressed as follows:

Victor K Sapphire
Connolly Bove Lodge & Hutz LLP
333 S Grand Avenue Suite 2300
Los Angeles, CA 90071.

Date: May 3, 2012

/Thomas D. Foster/
Thomas D. Foster, Esq.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted by electronic mail to the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, via the ESTTA system, on the date identified below.

Date: May 3, 2012

/Thomas D. Foster/
Thomas D. Foster, Esq.